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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,263	05/24/2001	Kazuo Tachiwama	330-237	9024

7590 05/13/2003

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EXAMINER
BOLDEN, ELIZABETH A

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

Office Action Summary	Application No.	Applicant(s)	
	09/863,263	TACHIWAMA, KAZUO	
	Examin r	Art Unit	
	Elizabeth A. Bolden	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8 and 15-26* is/are pending in the application.

4a) Of the above claim(s) *19-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8,15-18 and 23-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

Election/Restrictions

Applicant's election of Group I in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 19-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8, 15-18, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komorita et al., Japanese Patent 53-4023.

A translation of JP 53-4023 accompanies this action. In reciting this rejection, the examiner will cite this translation.

Komorita et al. teach an optical glass having overlapping ranges of components with instant claims 8, 15-16, and 23-26. See page 5, lines 7-16. Komorita et al. teach overlapping ranges of Abbe number and refractive index for the glass as recited in instant claims 23-26. See page 2, lines 17-22. Komorita et al. teach that the glass can be used for lenses of optical equipment. See page 3, lines 1-3. Komorita et al. teach forming the glass by melting and then pouring the melt into a mold. See page 9, lines 18-22.

Komorita et al. fail to teach any anticipatory examples or compositional ranges and optical property ranges sufficiently specific to anticipate the instant invention. However, Komorita et al. teach ranges of components and properties, which overlap the instant claims. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have selected from the overlapping portion of the ranges taught by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

The reference fails to teach the glass transition property as recited in instant claims 23-26, however, one of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same T_g as recited in claims 23-26.

Claims 8, 15-18, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi, Japanese Patent 54-090218 in view of Komorita et al., Japanese Patent 53-4023.

Translations of JP 54-090218 and JP 53-4023 accompany this action. In reciting this rejection, the examiner will cite these translations.

Takahashi teaches an optical glass having overlapping ranges of components with instant claims 8, 15-16, 24, and 26. See page 4, line 15 to page 5, line 3. Takahashi teaches overlapping ranges of Abbe number and refractive index for the glass as recited in instant claims 24 and 26. See page 2, line 21 to page 3, line 1. Takahashi teaches that the glass can be used for lenses of optical equipment. See page 3, lines 1-3. Takahashi teaches forming the glass by melting and then pouring the melt into a mold. See page 9, lines 4-10. Takahashi teaches that WO_3, Ta_2O_5, and ZrO_2 are added to the glass "as a loss-prevention agent". See page 5, lines 8-11.

Takahashi fails to teach the addition of Nb_2O_3 to the glass. Komorita et al. teach an optical glass having overlapping ranges of components with instant claims 8, 15-16, and 23-26. See page 5, lines 7-16 and the above rejection. Komorita et al. teach that Nb_2O_3 is added to the glass as a stabilizer as well as increasing the refractive index and decreasing the dispersion of the glass. See page 7, lines 10-13. Furthermore, Komorita et al. teach that ZrO_2, WO_3, and Ta_2O_5 are used as glass stabilizers. See page 7, lines 7-9 and 14-17 and page 8, lines 11-13.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a optical glass of Takahashi as suggested by Komorita et al. because the resultant optical glass would have the same optical properties of Takahashi with the added stabilizing properties of Nb_2O_3 as suggested by Komorita et al. See page 7, lines 10-13 of Komorita et al.

Response to Arguments

Applicants' arguments filed 24 February 2003 with respect to Komorita et al. (JP 53-4023) have been fully considered but they are not persuasive.

Applicants' argue that Komorita et al., JP 53-4023 fails to anticipate the instant claims since Komorita et al. discloses HfO_2 and the instant invention does not require the presence of HfO_2.

This argument is not deemed persuasive because the Applicants' present claims do not limit the amount of HfO_2 in the composition.

Furthermore, the Applicants use "comprising" terminology, which allows for the addition of other components even in major amounts. See MPEP 2111.03.which states:

> The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.

Therefore, the instant claims allow for the addition of HfO_2 even in large amounts.

Applicants' further argue that Komorita et al. fails to anticipate the instant claims since Komorita et al. does not discloses SiO_2, B_2O_3, La_2O_3, and Ta_2O_5 as essential components.

This argument is not deemed persuasive because Komorita et al. teach ranges of components and properties, which overlap the instant claims. See above rejection over Komorita et al. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 703-305-0124. The examiner can normally be reached on 8:30am to 6:00 pm with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DAVID SAMPLE
PRIMARY EXAMINER

EAB
May 9, 2003